

REMARKS

Claims 1-22 are pending in the application.

Claims 1-22 have been rejected.

Claims 1-22 remain pending in this application.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 103

In Section 3 of the July 23, 2008 Office Action the examiner rejected claims 1, 3-12 and 14-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0057657 to *La Porta, et al.*, hereinafter “La Porta” in view of U.S. Patent Publication No. 2004/0005884 to *Nieminen, et al.*, hereinafter “Nieminen” and further in view of U.S. Patent No. 6,580,699 to *Manning, et al.* hereinafter “Manning”. The Applicant respectfully traverses the rejection.

In Section 27 of the July 23, 2008 Office Action the examiner rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over La Porta reference in view of Nieminen reference and Manning reference as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 6,999,766 to *Padovani* hereinafter “Padovani”. The Applicant respectfully traverses the rejection.

In ex parte examination of patent applications, the Patent Office bears the burden of establishing a prima facie case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a prima facie basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a prima facie case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of a patent. In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The Applicant directs the Examiner's attention to independent Claim 1, which recites unique and novel limitations, including those emphasized below:

A wireless network capable of providing a MS-MS packet data call between a source mobile station (MS) and a destination mobile station (MS), said wireless network comprising:

a first base station capable of wirelessly communicating with said source mobile station;

a second base station capable of wirelessly communicating with said destination mobile station;

a mobile switching center capable of connecting said first and second base stations, wherein the mobile switching center is capable of sending an assignment request; and

a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations. [Emphasis Added]

Claim 1 comprises the limitation “a mobile switching center capable of connecting said first and second base stations, wherein the mobile switching center is capable of sending an assignment request.” This limitation is not taught or suggested by any of the prior art of record.

The office action dated July 23, 2008 notes that La Porte does not teach, suggest or anticipate “the correspondent node communicates to a destination mobile station, transferring packets directly, and the MSC sending an assignment request and receiving an assignment complete message”. (Office Action, July 23, 2008 pg. 3). In order to cure this deficiency, the Examiner states that the direct transfer is taught by Manning, noting “Manning discloses transferring data packets directly” (Col. 8 l. 56 – Col. 9 l. 12). Applicant respectfully disagrees. For the purpose of clarity, the applicant reproduces the cited section below:

1. A method for updating a radio network to packet data serving node (PDSN) a first R-P connection while a mobile station (NMS) moves from a first radio network to a second radio network, the first radio network being serviced by a first base station controller (BSC) and the second radio network being serviced by a second BSC, the method comprising the steps of: storing packet data session information including information about the first R-P connection and an associated PDSN when the MS is in the first radio network; and transferring the stored information to the second BSC when the MS moves into the second radio network, thereby allowing the second radio network to update the first R-P connection.

2. The method of claim 1 further comprising: if the MS can be connected back to the PDSN, using the PDSN for communicating to the MS while it is in the second radio network either by maintaining the first R-P connection with the PDSN or establishing a second R-P connection with the PDSN; and if the PDSN is not reachable by the second BSC, establishing a third R-P connection between a new PDSN and the second BSC for providing packet data services there between.

No where in the cited sections is “a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection” taught or suggested.

In addition, the Applicant respectfully submits that neither *La Porta* nor *Nieminen*, either alone or in combination, discloses, teaches or suggests “a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on

said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations,” as recited by independent Claim 1.

As discussed in paragraph [042] of the specification, as filed, this connection relates to a connection made between the first base station and the second base station. This connection, between base stations, is not taught or suggested by the prior art of record. In fact, the prior art is directed at using a connection routed either through a mobile station or through a PDSN, not directly from a first base station to a second base station. None of the prior art of record teaches a direct connection between a first and second base station through a packet data bearer connection.

In addition, the Examiner attempts to cure the deficiency of the prior art in reference to the “assignment request” by pointing to Manning. As previously explained, the assignment request may comprise an IP address and a mobile identifier. This two-part identification is not taught by the prior art of record. La Porta only discusses a mobile IP, and Niemaen does not cure this deficiency. Manning does not cure this deficiency, as it only asserts that an assignment request may be present, but fails to show that the assignment comprises both an IP address and a mobile identifier. Figure 6 cited by the examiner fails to show this two-part identification.

It is therefore respectfully submitted that none of the cited art of record teaches or suggests sending an assignment request.

Similar to independent Claim 1, independent Claim 12 recites “in response to the first message, initiating establishment of a second packet data bearer connection on the local IP network for transferring the data packets associated with the MS-MS packet data call directly between the

second and third base stations.” Accordingly, for the reasons discussed above in connection with Claim 1, independent Claim 12 is not made obvious by the cited art. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Dependent Claims 2-11, which depend from independent Claim 1, and dependent Claims 13-22, which depend from independent Claim 12, are also not made obvious by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

The Applicant also disagrees with the Examiner’s rejections of Claims 1-22 based on additional misdescriptions and/or misapplications of *La Porta*, *Nieminen* and *Manning* to at least some of Claims 1-22. However, the Applicant’s arguments regarding those other shortcomings of *La Porta*, *Nieminen* and *Manning* are moot in view of the Claim 1 arguments above. However, the Applicant reserves the right to dispute in future Office Action responses the appropriateness and the applications of *La Porta*, *Nieminen* and *Manning* to the claims of the present application, including the right to dispute assertions made by the Examiner in the July 23, 2008 Office Action.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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